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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/784,816 | 02/24/2004 | Naohiro Yamaguchi | 00862.023472. | 1151 |
| 5514 7590 07/21/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | | |
| EXAMINER | | | | |
| KASSA, YOSEF | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2624 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/21/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,816

Applicant(s)

YAMAGUCHI, NAOHIRO

Examiner

YOSEF KASSA

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 35 are 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (U.S. Patent 5,539,842).

With regard to **claim 1**, Schwartz discloses a checking step of determining based on a predetermined reference whether each digital document is to be stored in a compressed or non-compressed state (refer to col. 10, lines 29-33 and also refer to Fig. 1, items 102 and 103);

a compressing step of generating compressed data for a first digital document when it is determined in said checking step that the first digital document is to be stored in a compressed state (refer to col. 5, lines 37-40);

a non-compressing step of generating non-compressed data for a second digital document when it is determined in said checking step that the second document is to be stored in a non-compressed state (refer to col. 15, lines 15-22, input image (non-compressed image) stored in Memory 1201); and

a generation step of generating the archive file that stores both the compressed first digital document and the non-compressed second digital document (refer to col. 5, lines 20-23 and also refer to Fig. 1 and Fig. 12). Although, Schwartz reference does not expressly call for “stores a plurality of digital documents”, it would have been obvious if not inherent, that

Schwartz reference discloses digital photocopier for processing and stores a digital images in memory 103 of Fig. 1. Thus, an ordinary artisan would have recognized the term “digital image processing system” is used in Schwartz reference perform the same function as the above claimed invention.

With regard to **claim 2**, Schwartz discloses wherein the predetermined reference is an access frequency to each digital document (refer to col. 3, lines 19-23).

With regard to **claim 3**, Schwartz discloses wherein the predetermined reference is a format of each digital document (refer to col. 5, lines 19-23).

With regard to **claim 4**, Schwartz discloses wherein the predetermined reference is a compression ratio upon compressing each digital document (refer to col. 3, lines 48-52).
5.

With regard to **claim 5**, Schwartz discloses further comprising an extraction step of extracting a digital document from the archive file generated in the generation step (refer to col. 3, lines 10-16).

With regard to **claim 6**, Schwartz discloses further comprising an acquisition step of acquiring a desired digital document using a table, and wherein the table has location information of each stored digital document, and is contained in the archive file(refer to col. 5, lines 19-23).

With regard to **claim 7**, Schwartz discloses A computer program for making a computer execute respective steps in
an information processing method (refer to Fig. 1, item 1).

Art Unit: 2624

8.

Claim 8 is similarly analyzed and rejected the same as claim 7.

Claims 9-14 are similarly analyzed and rejected the same as claims 1-8.

With regard to **claim 35**, Schwartz discloses wherein the second digital document is decompressed in said non-compressing step when the second digital document has already been compressed, and wherein the second digital document is not compressed in said non-compressing step when the second digital document is already in a non-compressed state (refer to Fig. 1).

With regard to **claim 36**, Schwartz discloses wherein the first digital document is compressed in said compressing step when the first digital document is not compressed, and wherein the first digital document is not compressed in said compressing step when the first digital document is already compressed (refer to Fig. 1).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 7 defines a "a computer program for making..." embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed "a computer program for making..." can range

from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium storing a program...." or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Other Prior Art Cited

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. (5895455), (5606649), (5432870), (5388167), and (5159667).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF KASSA whose telephone number is (571) 272-7452. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on (571) 272-7401. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and (571) 273-8300 for after Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

08/17/2008.

/YOSEF KASSA/

Primary Examiner, Art Unit 2624